

REMARKS/ARGUMENTS

Status of Claims

Claims 1 to 4, 6 to 8, 12 to 14, 16 and 19 to 24 are pending in the application.

35 U.S.C. § 102 Claim Rejections

The Examiner has rejected claims 1 to 3, 6 to 8, 12 to 14, 16 and 19 to 24 under 35 U.S.C. 102(e) as being anticipated by Noel et al. (Noel), U.S. Publication No. 2005/0032539.

Controlling case law has frequently addressed rejections under 35 U.S.C. § 102. "For a prior art reference to anticipate in terms of 35 U.S.C. Section 102, **every element** of the claimed invention **must** be **identically** shown in a single reference." Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 677, 7 U.S.P.Q.2d 1315, 1317 (Fed. Cir. 1988; emphasis added). The disclosed elements must be arranged as in the claim under review. See Lindemann Machinefabrik v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). If any claim, element, or step is absent from the reference that is being relied upon, there is **no** anticipation. Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 230 U.S.P.Q. 81 (Fed. Cir. 1986; emphasis added). The following analysis of the present rejections is respectfully offered with guidance from the foregoing controlling case law decisions.

The Examiner has alleged in the current Office Action that all the limitations are disclosed by Noel. Applicant respectfully disagrees.

The Examiner alleges that based on the disclosure of Applicant's specification at page 16, lines 17 to 24, specifically that a particular example describing the qualifier flag includes four machine readable values, one of which is a talk channel request, Noel equivalently discloses a qualifier flag because Noel merely discloses requesting the ability to speak.

In the Response to Arguments section on page 2 of the Office Action, the Examiner states that Noel discloses a call participant using an interrupt button to request the ability to speak and the PTT server 140 sending a message to a current speaker that one of the call participants wants to interrupt the call on an urgent basis. The Examiner alleges on page 3 of the

Office Action “the call participant currently in a receiving in half duplex mode, currently receiving speech from the current speaker, making a talk channel request as described above, therefore Noel teaches the TCRM including a qualifier flag, where the call participant is the RHD device”. Applicant submits that the Examiner has too broadly equated the PTT server sending a message in Noel to the specific implementation of using a flag qualifier to indicate a number of possible actions initiated by a first user device, such as 1) a channel request, 2) a continuing channel request, 3) cancelling a channel request or 4) performing an automatic release of a transmit channel. Noel does not disclose any specific content of what is contained in the message sent by the PTT server. There are any number of possibilities of content of Noel’s message, without **every element** of the claim being **identically** shown in Noel, which Applicant clearly indicates is the case as Noel make no specific disclosure of a flag qualifier, Applicant submits that Noel can not be considered to anticipate claim 1.

Claim 1 further specifically recites “the second user device performing extended functionality in response to a value of the qualifier flag, wherein the extended functionality comprises at least one functionality selected from a group consisting of” (emphasis added) and three specific functionalities, none of which are simply “allowing the requesting call participant to speak” as the Examiner appears to be equating to the concept of performing extended functionality (see Office Action page 6).

Applicant directs the Examiner’s attention to page 16, starting at line 28, wherein the present specification specifically recites:

“In some embodiments, Flag value 1 is a default value for a non-extended functionality of the TCRM. In such a case the THD device treats the TCRM the same way it would treat a TCRM with no qualifier flag 53. In other embodiments Flag value 2 is a value to indicate that until the THD device receives a subsequent terminating or cancelling request from the RHD device, the current transmit channel request of the TCRM containing the qualifier flag 53 stands” (emphasis added).

Further detail regarding Flag values 3 and 4 are also provided. As Flag value 1 is indicated to be a non-extended functionality, the description of Flag values 2, 3 and 4 are extended functionality. Clearly, the extended functionalities performed by the second user device, in response to the qualifier flag are more than simply “allowing the requested call participant to speak” as alleged by the Examiner.

A first extended functionality includes “registering a continuing transmit channel request at the THD device”. Applicant submits that Noel makes no suggestion or specific disclosure of registering a continuing transmit channel request at the THD device. A second extended functionality is “cancelling a transmit channel request at the THD device”. Applicant submits that Noel makes no suggestion or specific disclosure of cancelling a transmit channel request at the THD device. Noel discloses “the current speaker has the option of allowing the call participant initiating the request to speak or placing the call participant into the queue” (paragraph [0025] of Noel). A third extended functionality is “performing automatic release of the transmit channel by the THD device”. Applicant submits that Noel makes no suggestion or specific disclosure of performing automatic release of the transmit channel by the THD device. As mentioned above Noel discloses “the current speaker has the option of allowing the call participant initiating the request to speak or placing the call participant into the queue” (paragraph [0025] of Noel) and furthermore states that “the current speaker exercises this option by manipulating a predetermined interface on mobile device 110”. The speaker having to manipulate a predetermined interface is not equivalent to “performing automatic release of the transmit channel by the THD device” (emphasis added) as recited in claim 1.

In the Response to Arguments section on page 3 of the Office Action, the Examiner alleges that Noel discloses performing extended functionality of automatically releasing the transmit channel. However as indicated above, Noel discloses “the current speaker has the option of allowing the call participant initiating the request to speak or placing the call participant into the queue” (paragraph [0025] of Noel) and furthermore states that “the current speaker exercises this option by manipulating a predetermined interface on mobile device 110”. Noel further states in paragraph [0025] that “If the current speaker elects to allow the call participant initiating the interrupt request to speak, the call participant is granted the ability to speak by the PTT server 140”. As a user needs to manipulate a user interface on a device in

order to allow a requestor to speak and the PTT server is ultimately granting the requestor ability to speak, a current speaker's device does not perform "automatic release of the transmit channel by the THD device" (emphasis added) as recited in claim 1.

The Examiner further alleges that a limitation "the TCRM including an identification of the first user device" recited in claim 1 is disclosed in Noel in the form "the participants identities are transmitted to the PTT server and stored". While the identities may be received at the PTT server and stored, Noel does not specifically disclose that the PTT server sends the current speaker the identity of the call participant who is requesting to transmit. Noel simply states that:

"the current speaker has the option of allowing the call participant initiating the request to speak or placing the call participant into the queue (460). The current speaker exercises this option by manipulating a predetermined interface on mobile device 110. If the current speaker elects to allow the call participant initiating the interrupt request to speak, the call participant is granted the ability to speak by the PTT server 140 (470) and a message is sent by the PTT server 140 to all or a select set of the mobile devices 110 participating in the call indicating a change in speaker is set to occur (480). If the call participant is not granted the ability to speak, that is transmit her speech to the others, then the caller is placed in the queue to await her turn based on the assigned priority level".

While Noel states the current speaker has the "option of allowing the call participant initiating the request to speak or placing the call participant into the queue", Noel does not explicitly disclose that the decision to allow the user to speak is made based on the current speaker's knowledge of the participant's identity, simply that one of two choices can be made regarding the requestor. It is possible that the current speaker makes a decision based on the request itself, without knowing the specific identity of the requestor as it is the PTT server that send out notification of the new speaker if the requestor is allowed to speak and if not allowed to speak, the requestor goes into a queue to await their turn to speak based on assigned priority.

As **every element** of claim 1 is not **identically** shown in Noel, Applicant submits that claim 1 is not anticipated by Noel and thus claim 1 is novel over Noel.

Claims 2, 3 and 6 to 8 are dependent upon claim 1. Claims 12, 21 and 24 are independent claims reciting an extended functionality limitation similar to claim 1. Claims 13, 14, 16, 19, 20, 22 and 23 are dependent upon claim 12, either directly or indirectly. For at least the same reasons discussed above with regard to claim 1, Applicant submits that claims 2, 3, 6 to 8, 12 to 14, 16 and 19 to 24 are also novel over Noel.

35 U.S.C. § 103 Claim Rejections

In rejecting claims under 35 U.S.C. § 103(a), the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). It is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d, 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), *viz.*, (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. Additionally, in making a rejection under 35 U.S.C. § 103(a) on the basis of obviousness, the Examiner must provide some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the appellant. *See Oetiker*, 977 F.2d at 1445. *See also Piasecki*, 745 F.2d at 1472. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445; *Piasecki*, 745 F.2d at 1472.

Applicant's analysis below demonstrates that the Examiner has failed to fulfil the initial burden for a finding of obviousness under 35 U.S.C. 103.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable having regard to Noel in view of Stubbs, U.S. Patent No. 6,930,994.

Applicant submits that claim 4 is patentable over Noel and Stubbs, as the Examiner has not properly determined the differences between the claimed invention and the prior art. Furthermore, the Examiner has not provided a valid explanation to support an obviousness rejection under 35 U.S.C. 103. Applicant's reasoning is detailed below.

Differences between the claimed invention and the prior art

The following is a discussion of why the cited references do not disclose all the elements of the rejected claims. While it may be considered that "the mere existence of differences between prior art and an invention does not establish the invention's non-obviousness", Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one skilled in the art (Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of the Supreme Court Decision in *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007)). As such, if elements from a claim are not disclosed by the combination of cited references and no valid reasoning is provided why the missing elements would be obvious, this may provide a strong basis for why a claim should not be rejected based on obviousness.

The Examiner points to Stubbs as teaching wherein the half-duplex session is a voice communication session compliant with at least one system selected from the group of iDEN.TM., 1XRTT CDMA, GSM/GPRS, UMTS, and TDMA. Claim 4 depends from claim 1. Even if Stubbs teaches what is alleged by the Examiner, which Applicant does not necessarily concede. Stubbs does not overcome the deficiencies of Noel outlined above concerning the rejection of claim 1. Accordingly, the combination of Noel and Stubbs does not render claim 4 obvious.

For at least the reasons discussed above, Applicant respectfully submits that the combination of Noel and Stubbs does not teach all the limitations recited in claim 4. Furthermore, the Examiner has failed to explain why the missing limitations would be obvious to one skilled in the art. Without all the limitations of claim 4 being disclosed by the two references and no reason provided by the Examiner why these missing limitations would be

obvious, Applicant submits that there are differences between what is recited in amended claim 4 and what is disclosed in the cited art that renders the claims non-obvious.

Reason to Combine

Once the scope of the prior art is ascertained, the content of the prior art must be properly combined. An obviousness inquiry requires a review of a number of factors, including the background knowledge possessed by a person having ordinary skill in the art, to determine whether there was an apparent reason to combine the elements of the prior art in the fashion claimed by the present invention. For the Patent Office to combine references in support of an obviousness rejection, the Patent Office must identify a reason why a person of ordinary skill in the art would have combined the references *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Even if the Patent Office is able to articulate and support a suggestion to combine the references, it is impermissible to pick and choose elements from the prior art while using the application as a template.

Applicant submits that there is no suggestion of a desirability of the claimed invention in the references that would serve as a reason for one skilled in the art to combine the references.

The Examiner's motivation for combining Noel and Stubbs is tied to a view that Noel teaches the particular limitations of claim 1 and thereby the same limitations in claim 4. As detailed above in view of the claimed subject matter of claim 1, this is an incorrect interpretation of Noel and as such this also affects the Examiner's reason for combining the cited references.

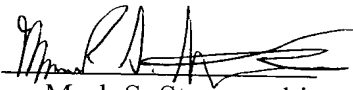
For at least the reasons discussed above concerning the rejection of claim 1, Applicant submits that claim 4 patentably distinguishes over the combination of Noel and Stubbs.

Applicant respectfully requests that the Examiner reconsider and withdraw the obviousness rejections of claim 4.

In view of the foregoing, early favorable consideration of this application is earnestly solicited. In the event that the Examiner has concerns regarding the present response, the Examiner is encouraged to contact the undersigned at the telephone number listed below.

Respectfully submitted,

RAO, KRISHINA ET AL.

By 
Mark S. Starzomski
Reg. No. 62,441
Tel.: 613-232-2486

Date: April 26, 2010

MSS:mcg